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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hugh Herr

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EXAMINER

BLANCO, JAVIER G

ART UNIT

PAPER NUMBER

3774

MAIL DATE

DELIVERY MODE

07/21/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/613,499	Applicant(s) HERR, HUGH	
	Examiner JAVIER G. BLANCO	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/2/2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-24 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) 26, 27 and 32-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-24 and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment of claims 12, 13, 15, 17, 18, and 21-24 in the reply filed on June 2nd, 2010 is acknowledged.
2. Applicant's cancellation of claims 2, 4-8, 10, 11, and 25 in the reply filed on June 2nd, 2010 is acknowledged.
3. Applicant's addition of claims 26-34 in the reply filed on June 2nd, 2010 is acknowledged.

Election/Restrictions

4. Newly submitted claims 26, 27, 32, 33, and 34 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the elected species, embodied in Figure 7, does not have elastic or pneumatic springs. The non-elected embodiments of, e.g., Figures 8, 12, and 13 are disclosed as the embodiments comprising elastic or pneumatic springs.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26, 27, 32, 33, and 34 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

5. Claim 28 is objected to because of the following informality:

Art Unit: 3774

a. Regarding claim 28, please substitute “portion at its forward and” (see line 11) with --portion at its forward **end** and--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 28-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

a. Regarding independent claim 28, the structural relationship between the “support member” and the “foot member”, and between the “spring” and the rest of the “prosthetic leg or orthotic leg” is unclear, rendering independent claim 28 indefinite as to the scope of the invention.

Is the “support member” attached to the “foot member”? How and where exactly is the “spring” attached to the “prosthetic leg or orthotic leg”? The structural relationship between the claimed components of the “prosthetic leg or orthotic leg” needs to be clearly indicated. Critical structure necessary for accomplishing the claimed function must be set forth. Claims 29-34 depend from claim 28.

b. Regarding each of dependent claims 29-32, how exactly can the “spring” be “coupled past both the knee joint and the ankle joint”, but then “decoupled from the knee joint”?

c. Regarding each of dependent claims 32-34, the limitation “the first spring” (see line 1) lacks antecedent basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 12-24 and 28-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **H. Sartin** (US 2,529,968).

Referring to Figures 1-7, H. Sartin discloses a prosthetic or orthotic leg comprising, in combination,

- a.** A mounting member (13/70) *for attaching* said prosthetic or orthotic leg to a biological limb of a human body,
- b.** A support member (11/41) connected at its upper end at a knee joint (75/72) *for rotation* with respect to said mounting member,
- c.** A foot member (10) including a rearwardly extending heel portion (14/15) and a forwardly extending toe portion (18) that make periodic bearing contact with the ground during a walking, running or jumping gate cycle of said human body, said foot member being connected at an ankle joint (34/44 and/or 64/65) to the lower end of said support member *for rotation* relative to said support member,
- d.** A first spring (54) *for storing* energy when said support member rotates about said knee joint *to move* said foot member rearwardly with respect to said knee joint and *for releasing* energy *to rotate* said support member about said knee joint *to extend* said support member, and

Art Unit: 3774

e. A second spring (57) *for storing* energy when said support member is rotated about said knee joint *to extend* said support member and *for releasing* energy *to rotate* said foot member about said ankle joint *to increase* the bearing force applied to the ground by said toe portion.

Regarding claims 13-16, 19, 20, and 21, the intended use (or functional) limitations are clearly shown in Figures 4, 5, and 6.

Regarding claims 17 and 22, the "connecting point" is one of 60, 52, 46, 47, and/or 62.

Regarding claims 18, 23, and 24, the figures clearly show the second spring as connected between said foot member and said support member, and capable of storing and releasing energy as said foot member rotates about said ankle joint.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). With regards to statements of intended use and other functional statements (e.g., *for attaching; for rotation; for storing; for releasing; to extend; to move; etc.*), they do not impose any structural limitations on the claims distinguishable over the device of Sartin ‘968, **which is capable of being used as claimed if one so desires to do so**. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus

Art Unit: 3774

claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

10. Claims 12-24 and 28-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Henschke et al.** (US 2,489,291).

Referring to Figures 1-4, **Henschke et al.** disclose a prosthetic or orthotic leg comprising, in combination,

- a.** A mounting member (thigh part 10) *for attaching* said prosthetic or orthotic leg to a biological limb of a human body,
- b.** A support member (**first interpretation:** shank 11; **second interpretation:** connecting element 15) connected at its upper end at a knee joint (knee joint 13) *for rotation* with respect to said mounting member,
- c.** A foot member (foot part 12) including a rearwardly extending heel portion and a forwardly extending toe portion that make periodic bearing contact with the ground during a walking, running or jumping gate cycle of said human body, said foot member being connected at an ankle joint (ankle joint 14) to the lower end of said support member *for rotation* relative to said support member,
- d.** A first spring (Figure 1: spring 23; Figure 3: spring 60) *for storing* energy when said support member rotates about said knee joint *to move* said foot member rearwardly with respect to said

Art Unit: 3774

knee joint and *for releasing energy to rotate* said support member about said knee joint *to extend* said support member, and

e. A second spring (Figure 1: spring 42) *for storing* energy when said support member is rotated about said knee joint *to extend* said support member and *for releasing energy to rotate* said foot member about said ankle joint *to increase* the bearing force applied to the ground by said toe portion.

Regarding claims 13-16, 19, 20, and 21, see columns 5-8 describing the intended use (or functional) limitations.

Regarding claims 17 and 22, the "connecting point" is one of fulcrum 16 and/or rod 24.

Regarding claims 18, 23, and 24, the figures clearly show the second spring as connected between said foot member and said support member, and capable of storing and releasing energy as said foot member rotates about said ankle joint.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). With regards to statements of intended use and other functional statements (e.g., *for attaching; for rotation; for storing; for releasing; to extend; to move; etc.*), they do not impose any structural limitations on the claims distinguishable over the device of **Henschke et al.** '291, **which is capable of being used as claimed if one so desires**

Art Unit: 3774

to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

“[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

Response to Arguments

11. Applicant's arguments filed June 2nd, 2010 have been fully considered but they are not persuasive.

a. Regarding each of **Sartin '968** and **Henschke et al. '291**, the Applicant argues that the “mechanism” is “*both structurally and operationally different from the Applicant's claimed invention*”. The Examiner respectfully disagrees.

Regarding each one of independent claims 12 and 28, the structural relationship between the “support member” and the “foot member”, and between the “spring” (or springs) and the rest of the “prosthetic leg or orthotic leg” is unclear. Is the “support member” attached to the “foot member”? How and where exactly is the “spring” (or springs) attached to the “prosthetic leg or orthotic leg”? The structural relationship between the claimed components of the “prosthetic leg or orthotic leg” needs to be clearly indicated. Critical structure necessary for accomplishing the claimed function must be set forth. Each of **Sartin '968** and **Henschke et al. '291** clearly

Art Unit: 3774

disclose the structural limitations as broadly claimed in claims 12-24 and 28-31, including functional limitations set forth in said claims. Therefore, none of **Sartin** '968 and **Henschke et al.** '291 is “*structurally and operationally different from the Applicant's claimed invention*”.

b. It is noted Applicant's arguments are only based on functional recitations. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). With regards to statements of intended use and other functional statements (e.g., *for attaching; for rotation; for storing; for releasing; to extend; to move; etc.*), they do not impose any structural limitations on the claims distinguishable over the device of each of **Sartin** '968 and **Henschke et al.** '291, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

Conclusion

12. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:00 a.m.-7:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571)272-4749. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 3774

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Javier G. Blanco/

Examiner, Art Unit 3774

/David H Willse/

Primary Examiner, Art Unit 3738